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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/932,163
Filing Date: August 17, 2001
Appellant(s): LESLIE ET AL.

MAILED

OCT 03 2007

GROUP 3600

Jack Friedman
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed June 25, 2007 appealing from the Office action mailed January 4, 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner.

Claims 34-36 and 46-48 35 USC 112 1st for failing to comply with the written description requirement. Claim 17 35 USC 112 1st for failing to comply with the enablement requirement as claim 17 had been previously cancelled.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,987,415	Breese et al	11-1999
5,848,396	Gerace	12-1998

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 1-2 and 11-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement as well as new enablement rejections on additional limitations. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.
2. Claims 1-2 and 12-16, 30 recite the limitations of "deducing a value" of variables, however the disclosure fails to teach how the "deducing" is done. Examples are given when a specific type of variable is used and what those variables indicate. However, there are no specific steps that would allow one skilled in the art to make and/or use the appellant invention to "deduce" the value of a variable. Applicant fails to identify how a

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variable is even identified and/or know to the user let alone how one would "deduce" a value of this unknown variable.

3. Claims 13, 20 and 25 recite the limitation of "majority-vote" algorithm. Applicants disclosure states using log entries in the majority-vote algorithm in which the log with the greatest number of entries is the majority and that type, however, the applicants disclosure fails to teach how one of ordinary skill in the art at the time of invention would identify what is placed into which category log. The disclosure makes suggestions by way of examples but not specific teaching for one to understand how to determine what action or event would be determined as for example extroversion or introversion.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-2, 11-16, 37-45 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 5,987,415 Breese et al; Modeling a Users Emotion and Personality in a computer user interface. Hereinafter referred to as Breese.

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6. As to claims 1 and 37 Breese teaches recording user behaviors and deducing a value for a personality/emotion of a user.(C. 11 I. 5-9; C. 12 I. 50-53).
7. deducing at least ONE value from the logged occurrences based on user characteristics(PC. 8 I. 19-23; 25-27; C. 11 I. 58-61)
8. recording the value in a database(C. 10 I. 39-42)
9. customizing presentation of information based on the values(C. 12 I. 62-66; C. 13 I. 31-35).
10. As to claims 2, 11 and 38-39 Breese teaches length of chat/time online(C. 10 I. 1-5 C. 12 I. 10-14).
11. As to claims 12 and 40 Breese teaches deducing the "best value"(C. 16 I. 55-58).
12. As to claims 13 and 41 Breese teaches the use of an algorithm for deducing the value(C. 10 I. 35-39; I. 53-56 C. 12 I. 29-22).
13. As to claims 14 and 42 Breese teaches storing a record of deduced personality value(C. 7 I. 13-16).
14. As to claims 15 and 43 Breese teaches customizing information according to the personality value(C. 13 I. 25-35).
15. As to claims 16 and 44 Breese teaches the method, system taking place over a network server(C. 4 I. 60-61).
16. As to claims 30 and 45 Breese teaches Myer Briggs(C. 8 I. 61-65).

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 34-36 and 46-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,987,415 Breese et al; Modeling a Users Emotion and Personality in a computer user interface as applied to claims 1-2, 11-16, 37-45 above, and further in view of US Patent 5,848,396 Gerace; Method and Apparatus for Deterring Behavior Profile of a Computer User; hereinafter referred to as Gerace.

19. As to claims 34-36 and 46-48 Breese teaches determining a value of a personality/emotion based on users reactions to a customized presentation (C. 7 I. 35-40 C. 15 I. 42-45). Breese fails to teach the identification of the end of a users internet session. However, Gerace teaches "After" multiple session information has been obtained making inferences from the recorded activity(C. 4 I. 15-18). It would have

been obvious to one skilled in the art at the time of invention to combine the teachings of Gerace with Breese so that they program has a complete log of information required and/or needed to appropriately identify the users personality type.

(10) Response to Argument

GROUND of Rejection 1 AND Ground of Rejection 2

The appellants arguments against the 35 USC 112 1st Enablement requirement are directed to showing support for "Deducing" a value. The examiners rejection is on the basis that the appellant has failed to set forth support in the disclosure for how one of ordinary skill in the art identifies what an "occurrence" is in relation to personality types. The characteristics and occurrences are the values that are used in performing the "deduction" of the at least one value. The examiner also asserts that the disclosure fails to teach that a "majority-vote" algorithm is the algorithm used by the appellant to "deduce" the values. The appellant states on Pg. 7 of the Brief that "Once taught the present invention those skilled in the art will understand that a number of other algorithms may be employed to test the contents or otherwise analyze the logs in order to deduce the values of the variables of the personality type indicator." The examiner notes that the enablement requirement is that the specification describe how to make and use the invention as defined by the claims. One test for enablement is that no undue experimentation be needed to practice the invention. The specification discloses multiple algorithm methods for "deducing" the value of the personality types. Therefore, the specification does not enable the specific scope of the claims for using the "majority-

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vote” algorithm, one skilled in the art would not know the “majority-vote” algorithm is the specific algorithm used by the appellant in order to allow one to make and or/use the invention to obtain the same results. The scope of the claims is narrower than allowed by the disclosure.

Additionally, as stated previously the appellant fails to set forth how one skilled in the art is to identify the “occurrences” of events as be of a particular personality type. The appellant gives examples of what could be construed as certain personality traits but fails to set for guidelines for how on skilled in the art would attempt to categorize the traits. In response to this same rational provided in the advisory action dated April 4, 2007, the appellant again responds with copied sections of the specification listing the examples referred by the examiner and alleges this describes what action or event would indicate extroversion or introversion. This example only applies to this scenario; the appellant fails to set forth guidelines for one to follow on how to identify occurrences for any implicitly relevant event. The examiner understands that not every scenario can be accounted for but some type of teaching such as teaching the “identifier” how to identify personality traits for the scope of the claimed invention, how does one know that a 2 minutes posting is determined to be extroversion vs. a 1 minute conversation to be introversion.

GROUND OF REJECTION 4

Before addressing the appellants rejections the examiner notes appellants arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out

how the language of the claims patentably distinguishes them from the references. Through out arguments addressing the prior art rejection the appellant continuously identifies sections Breese(prior art of record) and simply makes a statement of what the claim recites. The appellant fails to make any attempt to show how appellants claim language distinguishes itself from the prior art. The examiner will address the response to how the prior art is interpreted to read on the limitations of the claimed language and what the examiner believes the appellant is arguing the prior art is failing to teach.

Appellant argues on Pg. 17 of the Brief that Breese does not teach logging occurrences and does not mention "visiting a website". As to Breese not teaching a "logging occurrences" the examiner notes that on C. 13 I. 4-8 Breese teaches on observation interface of that receives inputs form the users keyboard and mouse. The examiner asserts this reads on logging of an occurrence. The examiner notes "logging" is a broad term which is being interpreted as recording or any type of input of information as the appellant has failed to further limit what constitutes a logging.

As to appellants argument that Breese fails to teach the internet websites, the examiner notes that Breese teaches the method and system taking place over a communication network(C. 61 I. 50-53) and teaches the network can be the internet which inherently includes websites. Furthermore, as claimed by applicant the logging is merely the users interaction with a website therefore, a mouse click is equivalent to an "interaction" with a website.

The appellant argues that Breese gives examples of analyzing responses being users behaviors such as angry vs. quiet voice. However, as shown above Breese also

accounts other "behavior" activities being observed by computer agent such mouse clicks and keyboard usage(C. 12 I. 65-67 to C.13 I. 4-8). The examiner notes that the appellant has not limited what is considered an "event", therefore the claims do not preclude the events also being an angry vs. Quiet voice.

The appellant argues that Breese fails to teach the user behaviors being logged. The examiner note logged is interpreted to be a file that keeps record of activities or events. Therefore, the examiner refers to C. 12 I. 50-55 in which user observations inputs(data transferred from the outside world into a computer system are used by the network module to determine emotional state. Additionally, C. 13 I. 10-20 discloses (1)Observe: when a concept is recognized a node is set to an appropriate value in the Bayesian network.

Appellant further argues that the behaviors are not logged or recorded but rather a "probability occurrence" is recorded. The examiner notes that in order for the probability to be determined the "scores" for the users utterances have to be identified and input somewhere into the system to calculate the probability of an emotional state. C 14 I. 30-30 C. 16 I. 30-45).

As to appellants arguments with regard to Breese failing to deduce a value based on users interaction with a web site the examiner refers to the previous remarks under this ground of rejection in which the examiner points out how and where Breese teaches these aspects.

Appellant argues that assessing greetings such as hi, hello, howdy, does not read on personality occurrences to deduced. As the examiner has previously indicated

the appellant has not made any attempt to limit the scope of the claim to preclude any such activity by the user being included as an occurrence of a personality event.

Appellant argues that Breese's probability of different states (which is agreed with by the appellant) does not "deduce" from logged occurrences of user interactions with a website. The examiner notes that Breese's probabilities are deduced/calculated/determined by observing user interactions over in a communication network(internet), the observations being that of a use of keyboard and mouse.

Appellant argues that Breese does not teach a "recording of each value...." The appellant simply argues that the prior art does not teach the "claimed recording" but fails to set forth any reasoning/rational of how the appellants claimed invention distinguishes itself from the capturing of a users emotional state. Appellant merely restates claim language and does not identify any differences..

As to appellants arguments that Breese fails to teach customizing presentation information from internet sites to the user according to the personality value of the user. Appellant identifies that Breese teaches "...the Bayesian agent network model and informs network what emotional and PERSONALITY state is to be projected(presented) to the user by the agent.". AS mention numerous times the before, Breese is teaching the method as a computer agent in a communication network such as the internet which inherently includes websites. IC. 8 I. 65-67).

As to appellants statement/argument that Breese does not teach information "From internet websites", the examiner notes the appellant is not claiming information FROM a website but rather a users interactions with a website. Therefore web

chatting(using a keyboard) or clicking through a site(using a mouse) with a computer agent is a users interaction with a website.

The examiner notes the appellant begins arguments address to the dependent claims rejection. The examiner will address the arguments but notes the claims depend from independent claims that have been rejected.

As to appellants arguments regarding the limitations of "wherein said characteristics of said user interactions..." the examiner notes where in clauses in a method claim are not given weight when it simply expresses the intended result of a process step previously recited. The appellants wherein interaction clauses simply express the type of information included in the characteristics and not a step of using the characteristics. The type of information will not change the previously recited step or how the interactions are used to "deduce" a value.

As to appellants arguments that Breese does not teach a "best value for each personality type." The examiner note Breese determines probabilities of an emotional and/or personality state. The probability is the likelihood of an event, thus the probability that the users personality state will be of this nature. The highest probability is used to determine the response of the computer agent interacting with the user.

The appellant argues that Breese fails to teach "generating a record..."(again with out any distinguishing how appellants claims distinguish). The examiner notes Breese teaches summing and recording scores of users phrases(C. 16 I. 46-48).

As to appellants arguments that Breese fails to teach retrieving the user record to be utilized for customizing information based on the personality type. The examiner

notes C. 16 I. 48-55 Breese teaches evaluating the stored information to determine the "best" probability to employ the agent to use to present information to the user. The examiner also notes how would one customize the agent if they did not have the record or previous information about the user to customize the agent. Customizing refers to meeting the individuals needs, therefore one would have to inherently know or have access to those needs prior to customizing(C. 16 I. 50-55).

As to appellants arguments regarding claims 16 and 44 in which the limitations are simply a summarization of all the steps previously claimed, argued and responded to such as observing, recording, deducing, generating, storing and customizing being performed according to programmable instructions on a server. Examiner fails to see what the appellant is argue and unable to respond except to refer appellant to previous response regarding these limitations.

As to appellants arguments that Breese fails to ~~teach~~ teach observing MBTI by an computer based agent. The examiner notes appellants interpretation of the prior art is incorrect. In C. 8 I. 61-67 Breese address how Psychologists have used physical laboratory tests(galvanic skin response and heart rate) to measure emotional state such as MBTI and that a computer agent does not have sensors to measure these responses. Appellant interprets this to mean a computer agent is not capable of measure personality traits such as MBTI. However, Breese states the computer agent does not have "sensors" to perform tests such as a skin test or heart rate. However, the computer agent utilizes other resources of information in connection with MBTI to identify the emotional state such as mouse keyboard. The examiner notes that Breese

also discloses using microphones and cameras connected to the computer agent to determine emotional state as well.

GROUND OF REJECTION 5

Since claims 34-46 depend from claim 1, which examiner has responded to arguments supra maintaining the unpatentability, the examiner additionally maintains claims 34-46 are likewise unpatentable over Breese in view Gerace.

The examiner additionally notes since appellant has failed to argue why/how the claims distinguish themselves over the prior art rather than merely reciting the claimed language the examiner is unable to respond aside from maintaining that the rejection teaches the limitations of the claimed language.

The appellant has failed to submit evidence as to why a prima facie case has not been established. The examiner notes the rationale supplied, the need for a complete record that is needed to appropriately identify the user for which to present the customization.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Traci L. Casler



Conferees:

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